

REMARKS

The Office Action mailed January 21, 2010, has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

35 U.S.C. §112, Sixth Paragraph

Claims 1-14 have been amended to expressly recite “means for” limitations to thereby more clearly invoke 35 USC 112, sixth paragraph. Quoting from *In re Donaldson* (16 F.3d 1189, 29 USPQ2d 1845 Fed. Cir. 1994), to which the Office Action refers,

the ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

Rejection(s) Under 35 U.S.C. § 102

Claims 1-6 and 12-14 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Bolomey et al. (U.S. pat. no. 6,424,597; hereinafter, “Bolomey”). Applicants respectfully traverse.

The basis of the prior art rejection is that Applicants’ claims read on Bolomey because the claims do not properly invoke 35 USC 112, sixth paragraph. In view of the above amendment, Applicants respectfully submit that the claims are now in means-plus-function format and accordingly invoke 35 USC 112, sixth paragraph, and a proper reading thereof must take into account corresponding structure in the specification. Thus for instance the recited “means for bringing the elements into contact with the surface of an object to be checked” (claim 1), must be interpreted in light of its description in for example FIG. 1 and corresponding disclosure. Bolomey, as previously explained, does not disclose such means, falling instead into the class of prior art over which the presently-claimed invention improves.

Rejection(s) Under 35 U.S.C. § 103(a)

Claims 7-11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bolomey as applied to claim 1-6 and 12-14, above, and further in view of Bjorner et al. (U.S. pat. no. 5,485,263; hereinafter, “Bjorner”).

Claims 7-11 variously depend, directly or indirectly, from the base claims addressed above. Bjorner fails to remedy the above-mentioned shortcomings of Bolomey with respect to the base claims. Accordingly, claims 7-11, which by definition include all the limitations of the base claims, are patentable over the combination of these references.

Double Patenting Rejection

Claims 1-2 and 13 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of Bolomey. Applicants respectfully traverse.

The Office Action alleges that instant claims 1-2 and 13 are unpatentable over claims 1 and 3 of Bolomey because instant claims 1-2 and 13 are broader, and it would have been obvious to broaden claims 1 and 3. It is not clear in what sense instant claims 1-2 and 13 are considered broader, and the Office Action does not elaborate on this position. In any case Applicants take issue with the contention that instant claims 1-2 and 13 are broader, and refer to the recitation of the “means for bringing the elements into contact with the surface of an object to be checked” found in instant claim 1 but absent from claim 1 of Bolomey. Such a feature alone controverts the claim that instant claim 1 is broader than claim 1 of Bolomey.

In addition, Applicants respectfully submit that the desire to make claims broader is not proper motivation upon which to base a *prima facie* case of obviousness. Such an alleged basis for obviousness does not substantively address the claimed subject matter and is inconsistent with any articulated guidelines in case law or in the rules of patent practice relating to obviousness, and the double patent rejection based thereon should be withdrawn.

The Office Action appears to rely on “*In re Goodman*,” presumably 11 F.3d 1046, 29 USPQ 2010 (Fed. Cir. 1993), as a basis for the double patenting rejection. However, the discussion in the MPEP of *In re Goodman* that is most closely applicable to the current situation relates to the presentation of a generic claim in an application, after a species has been claimed in an issued patent (MPEP §806.04(i)). The Office Action, however, has not made a case that Applicants’ instant claims 1-2 and 13 are generic and claims 1 and 3 of Bolomey are directed to a species, and it is respectfully submitted that this is in fact not the situation at hand.

Conclusion

In view of the preceding discussion, Applicants respectfully urge that the claims of the present application define patentable subject matter and should be passed to allowance.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

Please charge any additional required fees, including those necessary to obtain extensions of time to render timely the filing of the instant Amendment and/or Reply to Office Action, or credit any overpayment not otherwise credited, to our deposit account no. 50-3557.

Respectfully submitted,
NIXON PEABODY LLP

Dated: April 21, 2010

/Khaled Shami/
Khaled Shami
Reg. No. 38,745

NIXON PEABODY LLP
200 PAGE MILL ROAD
2ND FLOOR
PALO ALTO, CA
94306-2022
TEL. (650) 320-7700
FAX. (650) 320-7701